



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/126,826 | 07/31/1998 | SHUNPEI YAMAZAKI | 07977/019002 | 9346 |
| 20985 | 7590 | 08/27/2003 | EXAMINER | |
| FISH & RICHARDSON, PC 4350 LA JOLLA VILLAGE DRIVE SUITE 500 SAN DIEGO, CA 92122 | | | NGUYEN, DUNG T | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2871 | | |

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/126,826 | Applicant(s) Yamazaki et al. |
| | Examiner Dung Nguyen | Art Unit 2871 |

un

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Jun 12, 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 44-48, 51-54, 70, and 72-104 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 44-48, 51-54, 70, and 72-104 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 30-31
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

Art Unit: 2871

DETAILED ACTION

Applicant's dated 011/19/2002 has been received and entered.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 72-83, 90-99 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mawatari et al., US Patent No. 5,200,847, in view of Yamazaki et al., US Patent 5,821,559, as stated in the previous office action.
3. Claim 44-48, 51-54 and 72 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mawatari et al., US Patent No. 5,200,847, in view of Yamazaki et al., US Patent 5,821,559, further in view of Sawatsubashi et al., US Patent 5,148,301, as stated in the previous office action.

Regarding claims 44, 72, 78, 90 and 95, Applicants contain that the cited prior art does not teach or suggest the feature of "a base film in contact with said resin" (reply, page 2), since the reference numeral 118a does not disclose a base film (refly, page 3). The Examiner is not convinced by this argument since the same is true of the Mawatari et al. substrate (118a). It should be noted that the term "base film" denotes for "a supported layer"; thus, one of ordinary skill in the art would be able to interpret the term a base film as a fundamental part of something formed thereon such as a driving circuit (120) formed over a base film (substrate 118a). In other

Art Unit: 2871

words, the Mawatari et al. substrate (118a) and the Applicants' base film would be the same as well.

Accordingly, the limitation of the above claims met.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 44-48, 51-54, 70, 72-104 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17 and 24 of U.S. Patent No. 5,834,327, as stated in the previous office action.

Regarding the double-patenting rejection, Applicants, again, contain that claim 17 (Yamazaki et al., US 5,834,327) fail to disclose the resin or the base film formed in contact with the resin (rely, pages 3-4). The Examiner, as stated in the office action dated 03/11/2003, respectfully disagrees with the Applicants' viewpoint, and, again, respectfully invited Applicant to review claim 17 which disclose a step of forming an underlying film (i.e., a base film) (emphasis

Art Unit: 2871

added) on a peeling layer and step of attaching driver circuit to one of a liquid crystal substrates with an adhesive (i.e., a resin layer)(emphasis added) therebetween, and then etching the peeling layer for separating a semiconductor integrated circuit (formed on the underlying film) from the glass substrate; and one of ordinary skill would be able to merely find such base film would be formed in contact with such resin layer.

Accordingly, the rejection of claims 44-48, 51-54, 70-104 under the judicially created doctrine of obviousness-type double patenting proper.

Response to Arguments

6. Applicant's arguments filed 06/12/2003 have been fully considered but they are not persuasive as noted above.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

Art Unit: 2871

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Dung Nguyen whose telephone number is (703) 305-0423. The Examiner can normally be reached on Monday-Thursday

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's supervisor, Robert H. Kim can be reached on 703-305-3492. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7730 for regular communications and 703-308-7726 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0956.

DN
08/25/2003



Dung Nguyen
Patent Examiner
GAU 2871